UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/625,878
Filing Date: July 24, 2003
Appellant(s): KEENER, MARK BRADFORD

Wendy Buskop

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Feb. 26, 2009 appealing from the Office

action mailed January 22, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings

known to the examiner which may be related to, directly affect or be directly affected by

or have a bearing on the Board's decision in the pending appeal:

CAUSE NO. 2007-67481

JOSEPH M. HILL, AS CHAPTER 7 TRUSTEE of the ESTATE OF MARK & ROBIN KEENER	§	IN THE DISTRICT COURT OF
PLAINTIFF, vs.		HARRIS COUNTY, TEXAS
BMC SOFTWARE, Inc.		
DEFENDANT		215 TM JUDICIAL DISTRICT

November 1, 2007 above lawsuit was filed in Texas state District Court

November 30, 2006 Defendant removed to Federal Court.

April 2, 2008 Federal Court Orders Remanded case to State Court.

May 15, 2008 Appeal of Defendant's was dismissed by Federal Court Order.

Case is still pending with claims for theft of trade secret and patent

infringement and copyright infringement claims.

(3) Jurisdictional Statement

The statement in the brief is correct.

(4) Table of Contents

The table of contents is noted.

(5) Table of Authorities

The table of contents is noted.

(6) Status of Amendments

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(7) Grounds of Rejection to be Reviewed

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(8) Statement of Facts

The statement of facts is noted.

(9) Argument

The argument is noted.

(10) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(11) Evidence Relied Upon

2002/0169658   ADLER   3-2002

(12) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 1, 4-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, elements (f), sub-elements (i)-(xiii), are vague because it's unclear whether the data/program of (i)-(xii) are being used since they are merely intended use of the manipulated data and programs of element (f) which includes statements such as "for identifying ...to form ...for inputting data and forming in the data storage of the device for the manipulation of data and programs...". There are no tying such descriptions to positive claim language normally required in an apparatus claim such as produced when on uses the term "configured" or, even more positively, 35 U.S.C, six paragraph language, such as "means plus function" language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.

3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
        obviousness or nonobviousness.

1.   Claims 1, 4-27 are rejected under 35 U.S.C. 103(a) as obvious over ADLER.

claim 1 is as followed:

1.   (Currently Amended) A system for identifying relationships between business

processes and technology using a protocol to form a dependency and impact hierarchy,

wherein the system comprises:

a. a device adapted for manipulating data and programs comprising a processor

with data storage;

b. a device adapted for inputting data and programs to the device adapted for

manipulating data and programs,

c. a device adapted for viewing data and programs in communication with the

device adapted for inputting data and programs;

d. a user input device for input of data and programs from a user;

e. a network in communication with the devices for inputting, viewing and

manipulating data and programs; and

f. wherein the device adapted for manipulating data and programs comprises

computer instructions for identifying relationships between business processes

and technology using a protocol to form a dependency and impact hierarchy, and

computer instructions for inputting data and forming in the data storage of the

device for the manipulation of data and programs all of the following:

i. a business organization object layer;

ii. a business unit object layer;

iii. a business process object layer;

iv. a mechanism object layer;

v. a client object layer comprising an application user interface executable on

the a user input device;

vi. an input device object layer;

vii. a shared infrastructure services object layer <u>indicating</u> comprising a technical

service;

viii. an application object layer;

ix a shared data storage object layer comprising a shared data storage

technical infrastructure object;

x. a server object layer comprising a server technical infrastructure

component;

xi. a network object layer comprising a network technical infrastructure

component;

xii. a shared network infrastructure object layer comprising an individual network

object; and

xiii. a security device object layer comprising a security device technical

infrastructure component, wherein the object layers are arranged vertically creating

vertical dependencies and the object layers are in a constant and static arrangement.

Note that independent claim 1 is an apparatus claim. In examination of the

apparatus claim, the claims must be structurally distinguishable from the prior art. While

features of an apparatus claim may be recited either structurally or functionally, claims

directed to an apparatus must be distinguished from the prior art in terms of structure

rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44*

USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not

what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990).

Manner of operating the device or elements of the device, i.e. recitation with respect to

the manner in which a claimed apparatus is intended to be employed/used, does not

differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647

(BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device

or apparatus, i.e.

1) In the preamble: "for identifying relationships between business processes and

technology using a protocol to form a dependency and impact hierarchy" carries no

patentable weight.

2) Element (d): "for input of data and programs from a user" carries no patentable

weight.

3) Element (e): "for inputting, viewing and manipulating data and programs"

carries no patentable weight.

4) Element (f): "for identifying relationships between business processes

and technology using a protocol to form a dependency and impact hierarchy" and

"for inputting data and forming in the data storage of the device for the manipulation of data and programs all of the following....", carries no patentable weight.

Also, the term "adapted for" in elements (a.), (b.), (c.) and (f) are interpreted as "being capable of".

Similarly, ADLER fairly discloses a system for identifying relationships between business processes and technology using a protocol to form a dependency and impact hierarchy, wherein the system comprises:

a. a device adapted for manipulating data and programs comprising a processor with data storage;

{see Fig. 3 and 3A, elements 302, "CREATE", 305, "CONTROL", 307 "GUI FOR ANALYSIS", "ASSESS/DECIDE", and paragraphs [0163-0168] which basically disclose the usage of computers, servers, conventional network hardware and software, LAN/WAN and other types of computers and network resources, etc., to carry out the data input and strategic business analysis and modeling decisions}

b. a device adapted for inputting data and programs to the device adapted for manipulating data and programs,

{see Fig. 1A, 3, element 35 "Data Import Wizard", and 3A, element 306, 304 "IMPORT", paragraphs [0163-0168]}

c. a device adapted for viewing data and programs in communication with the device adapted for inputting data and programs;

{see Figs. 1, 1A, 3, element 37 "GUI", Fig. 3A, elements 301, 307, "GUI", and Fig. 6}

d. a user input device for input of data and programs from a user;

{see Figs. 1, 1A, 3, element 35 "Data Import Wizard", Fig. 3A element 306, 304

"IMPORT"}

e. a network in communication with the devices for inputting, viewing and

manipulating data and programs; and

{see Figs. 3A, element 300, GUI 301, 307, 3, 12, 13 and 16, and paragraphs

[0163-0168] which basically disclose the usage of computers, servers, conventional

network hardware and software, LAN/WAN and other types of computers and network

resources, etc., to carry out the data input and strategic business analysis and modeling

decisions]}

f. wherein the device adapted for manipulating data and programs comprises

computer instructions for identifying relationships between business processes

and technology using a protocol to form a dependency and impact hierarchy, and

computer instructions for inputting data and forming in the data storage of the

device for the manipulation of data and programs all of the following:

{see Fig. 3, 3A, elements 301, "UI FOR MODELING", 305 "CONTROL",

"SIMULATION ENGINE", 307, "UI FOR ANALYSIS", Fig. 5A, and 12, and paragraphs

[0163-0168] which basically disclose the usage of computers, servers, conventional

network hardware and software, LAN/WAN and other types of computers and network

resources, etc., to carry out the data input and strategic business analysis and modeling

decisions}

As for the different layers as shown in (i)-(xii), they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated above. Moreover, the different layers are shown in Fig. 4, 5A, 12 and 16, pars. [0058-0060]. Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business modeling system.

As for dep. claims 2-27 (part of 1 above), which deal with parameters with respect to hierarchical layers or hierarchical relationship and program files to carry out the object layers, they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated above. Moreover, the parameters about the object layers and relationships of the layers are shown in Fig. 7 and 8 and 9. Also, the program files or data files to carry out the apparatus claims are inherently included in the teachings of Fig. 3 of ADLER. Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business system.

Note that independent claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure

rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44*

USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not

what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990).

Manner of operating the device or elements of the device, i.e. recitation with respect to

the manner in which a claimed apparatus is intended to be employed/used, does not

differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647

(BPAI, 1987).

Also, this is an apparatus claim and <u>intended use</u> limitation for the system/device

or apparatus, i.e.

1) In the preamble: "for identifying relationships between business processes and

technology using a protocol to form a dependency and impact hierarchy" carries no

patentable weight.

2) Element (d): "for input of data and programs from a user" carries no patentable

weight.

3) Element (e): "for inputting, viewing and manipulating data and programs"

carries no patentable weight.

4) Element (f): "for identifying relationships between business processes

and technology using a protocol to form a dependency and impact hierarchy" and

"for inputting data and forming in the data storage of the

device for the manipulation of data and programs all of the following…..", carries no

patentable weight.

Also, the term "adapted for" in elements (a.), (b.), (c.) and (f) are interpreted as "being capable of".

(10) Response to Argument

Applicant's major arguments on pages 11-15 with respect to the thirteen object layers of dependency/impact hierarchical model, as shown on items (i)-(xiii) in claim 1, that represent individual technical infrastructure components are noted, however, as indicated above, claim 1 is an apparatus claim, and these object layers are not considered as structural elements or functional elements thus having no patentable weight in an apparatus claim. Furthermore, these object layers depend on the device which merely calls for "adapted for" which is considered as "capable of" and the networks system of ADLER, as shown on paragraphs [0163-0168] and Figs. 3, 3A, 12 are capable of carrying out these features. Furthermore, the main feature argued as shown on element (f): "***for identifying*** relationships between business processes and technology using a protocol ***to form*** a dependency and impact hierarchy" and "***for inputting*** data and ***forming*** in the data storage of the device for the manipulation of data and programs all of the following....", are all considered as "intended use" and carry no patentable weight.

Moreover, the different layers are shown in ADLER Fig. 4, 5A, 12 and 16, pars. [0058-0060]. Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business modeling system.

Applicant's response to the 112, 2nd rejections on page 15 is noted, but however, it's not found to be persuasive because the data/program of (i)-(xii) are merely intended use of the manipulated data and programs of element (f) which includes statements such as "for identifying ...to form ...for inputting data and forming in the data storage of the device for the manipulation of data and programs..." and no proper responses to show these are structural elements have been submitted. There are no tying such descriptions to positive claim language normally required in an apparatus claim such as produced when on uses the term "configured" or, even more positively, 35 U.S.C, six paragraph language, such as "means plus function" language.

Applicant's on page 17 with respect to the "Evidence of licensing" as a secondary consideration to overcome the claims based on 103 rejections is noted, however, it's not found to be persuasive because it's not clear what is included in the "licensing", whether the licensing includes the limitation of claim 1 or not, and other variables related to the licensing outside of the claimed patenting application.

It's the Examiner's position that Applicant's non-responsive to the Examiner's lack of patentability of other claims, dependent claims 4-27 as shown on page 18, is taken that the applicant has admitted that the rejections of these claims are valid and these claims stand or fall together with the specific claims argued by the applicant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689

<u>Conferees</u>:

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